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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,659	07/20/2000	Tommy Abrahamsson	1103326 0629	9094

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EXAMINER	
LUKTON, DAVID	
ART UNIT	PAPER NUMBER
1653	5

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/600,659	Applicant(s) Abrahamsson
	Examiner David Lukton	Art Unit 1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *one* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 7, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-23, 25-33, and 41-63* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-23, 25-33, and 41-63* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Pursuant to preliminary amendment, claims 24, 34-40 have been cancelled, claims 1-3, 8-11, 15-19, 23, 25, 27, 28, 30, 32, 33 amended, and claims 41-63 added. Claims 1-23, 25-33, 41-63 are pending.

The abbreviation "CPU" hereinbelow refers to carboxypeptidase U.

*

A restriction is imposed. First, however, the following subgenera are defined:

G1: the "CPU" inhibitor is limited to those recited in claim 2;

G2: the "CPU" inhibitor is limited to those recited in claim 3;

G3: the "CPU" inhibitor can be whatever the claims permit, provided that G1 and G2 are excluded.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1, 2, 4-8, 41, 42, drawn to compositions, limited to G1.

2. Claims 1, 3-8, 41, 42, drawn to compositions, limited to G2

3. Claims 1, 4-8, 42, drawn to compositions, limited to G3.

4. Claims 9-23, 43-56 drawn to a kit, limited to G1.

5. Claims 9-23, 43-56, drawn to a kit, limited to G2.

6. Claims 9, 11-17, 19-23, 47, 54, drawn to a kit, limited to G3.

7. Claims 25-33, 57-63, drawn to a method of using the composition of Group 1

8. Claims 25-33, 57-63, drawn to a method of using the composition of Group 2

9. Claims 25, 26, 28-33, 61, drawn to a method of using the composition of Group 3

The claimed inventions are distinct.

Claim 1 has been sequestered into three parts, depending on the "CPU". However, in the event that applicants elect Group 1, and the "CPU" inhibitor compounds prove to be novel, the possibility of rejoining Group 2 will be considered, and *vice versa*.

Groups 1-3 and 4-6 are sequestered from one another at this time because the possibility exists that applicants could amend the "kit" claims to recite a specific third component which would require a further search. In addition, it is possible that a given reference might teach a mixture which just happens to contain a thrombin inhibitor and a CPU inhibitor, without necessarily providing a motivation to combine the two. Notwithstanding the foregoing, in the event that applicants elect any of Groups 1-3, and claims therein found allowable, the correspondin "kit" claims will be rejoined therewith, subject to the same limitations.

Inventions 1-3 and 7-9 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

806.05(h)). However, in the event that any of Groups 1-3 is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination (subject to the same limitations on the inhibitors).

The "371" status of the application is noted. It is asserted, however, that "unity of invention" does not exist, since there is motivation to combine thrombin inhibitors with CPU inhibitors. CPU is not only involved in fibrinolysis, but is also involved in inflammatory processes because of its ability to inhibit anaphylatoxins. Similarly, thrombin is involved in both fibrinolysis and inflammation. Accordingly, claim 1, at least is *prima facia* obvious.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect species. In the event that applicants elect one of Groups 1-6, election of a specific CPU inhibitor and a specific thrombin inhibitor is required. In the event that that applicants elect one of Groups 7-9, a second species election is required, namely a specific disorder to be treated.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are witten in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

✺

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.